

REMARKS

Applicants offer the following remarks with respect to the rejections of claims 13-18.

1. Claims 15 and 16 are rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner indicates that the term "the shoulder" lacks proper antecedent basis. Applicants have amended claims 15 and 16 to provide the proper antecedent basis. Accordingly, applicants request this rejection be withdrawn.

3. Claims 17 and 18 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,867,023 (hereinafter referred to as the "'023" patent). Specifically, the Examiner indicates that FIG. 3 of the '023 patent shows a blade magazine with all of the recited parts. Applicants respectfully disagree with the Examiner's characterization of the references and the rejection based thereon.

The classic test for anticipation, under 35 U.S.C. §102, requires that every limitation in a claim must be present in a single source reference for that reference to "anticipate" the claimed invention. Applicants respectfully submit that the '023 patent cannot anticipate the apparatus recited in claims 17 and 18 because every limitation within the respective claims are not present within the '023 patent.

Claim 17 of the present application recites a blade magazine for use in a head assembly of a matboard cutting machine, which magazine includes: (a) a body; (b) a slot disposed in the body, the slot sized to receive a cutting blade; (c) a flange disposed contiguous with the slot; and (d) a means for holding a cutting edge of the blade in contact with the flange.

The '023 patent discloses a magazine having two halves 222, a blade disposed between the two halves 222, and an adjustment screw 248. Each half 222 of the magazine has a ledge element 242 and a corresponding recess element 244. When assembled "the ledge element 242 of one plate is seated within the corresponding recess 244 of the other" (col.8, lines 35-38). "Because of the added thickness contributed by the

surface sections 238, and the corresponding width of the marginal elements 242, the paired plates define a thin cavity of planar configuration... The spacing of the walls is sufficient to permit the cutting blade 252 to be freely inserted between the plates" (col. 8, lines 45-51).

Applicants respectfully submit that the magazine of the '023 patent does not disclose "a means for holding a cutting edge of the blade in contact with the flange" as is recited in claim 17. As stated above, the blade 252 is freely inserted between the plates 222. Hence, there is no portion of the blade 252, including the cutting edge (unnumbered), that is *held in contact with a flange*. Consequently, there can be no means for holding a cutting edge of the blade in contact with the flange. Applicants direct the Examiner to FIGS. 13, 14, and 18-20, and to the last paragraph on page 9 of the specification (i.e., "The locations of the oblique shoulders 148..."). The specification clearly shows the relationship between the shoulder 148 and the blade 112 (shown in phantom in FIGS. 18-20), and how the screw 146 holds the blade edge against the shoulder 148. There is no such structure disclosed within the '023 patent. In fact, that point is made on page 10 of the current specification.

Claim 18, which depends from claim 17, adds additional limitations to the blade magazine of claim 17. These additional limitations further distinguish the claimed magazine from that disclosed within the '023 patent.

For at least the reasons identified above, applicants respectfully request the Examiner withdraw the stated rejection and allow claims 17 and 18.

5. Claims 13-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 3,967,519 issued to Esterly (hereinafter referred to as "Esterly") in view of the '023 patent. Applicants respectfully disagree with the Examiner's characterization of Esterly and the '023 patent, and the rejection based thereon.

When an application is submitted to the Patent and Trademark Office, statute and case law dictates that the burden of proof is on the PTO to establish a *prima facie* case of obviousness. Once the *prima facie* case has been established, then the burden of going forward with the evidence to rebut the *prima facie* case shifts to the applicant. Only the burden of going forward with evidence to rebut shifts to the applicant, however. The burden of persuasion remains with the PTO. In this instance, a *prima facie* case would necessarily

have to first establish that the combined teachings of Esterly and the '023 patent render the claimed subject matter obvious, and second provide a suggestion or motivation within the cited references to combine the cited references to arrive at the claimed invention. The suggestion or motivation to combine the references must not be a hindsight reconstruction of isolated disclosures within the prior art. Indeed, the lack of an appropriate motivation or suggestion to combine gives rise to an inference that the combination is the product of hindsight.

Claim 13 of the present application recites a head assembly for a cutting machine, that includes:

- (a) a head having mounting means for movement of said head assembly on an axis, said head defining a first channel oriented at an oblique angle to said axis;
- (b) a slide mounted for slidable movement in said first channel between a withdrawn blade position and a plunged blade position, said slide having a second channel therein extending substantially parallel to said first channel, and said slide and head having cooperating mechanical means thereon for adjustably limiting the movement of said slide to said plunged blade position; and
- (c) a blade-holding magazine dimensioned and configured for slidable insertion into said second channel, wherein the magazine includes means for securing a blade to the magazine.

Esterly, in contrast, discloses a multidirectional web cutter that has a rotatable blade assembly 28 that includes a "blade 32 supported in blade housing 34 by blade clamp 36 and thumb screw 38 as shown in FIGS. 2 and 3" (col.2, lines 27-29). Esterly further discloses a "blade slide 57 *on which is mounted* the blade 32..." (col.2, lines 45-46; emphasis added). Hence, Esterly does not disclose a blade-holding magazine as is claimed in claim 1 (i.e., a blade-holding magazine dimensioned and configured for slidable insertion into a second channel within a slide). Rather, Esterly discloses that a blade 32 is mounted on a slide 57 by a clamp 36 and screw 38. There is no magazine or channel within a slide, and there is consequently no magazine dimensioned and configured for slidable insertion into the channel within the slide. The differences between the magazine of the '023 patent and the magazine of the present invention are described above.

The relationship between the blade-holding magazine and the slide of the present invention is significant and provides considerable utility not possible with the Esterly device. For example, applicants direct the Examiner to FIGS. 18-20, and to the last paragraph on page 9 (i.e., "The locations of the oblique shoulders 148..."), of the present specification, wherein the significance and advantage of the magazine / slide combination are detailed. Applicants respectfully traverse the Examiner's statement that it "would have been obvious to one of ordinary skill in the art to have modified Esterly making the blade holder be a blade magazine in a channel... in order to more firmly hold the blade and prevent lateral dislocation of the blade". The arrangement of Esterly does clamp the blade in a firm manner apparently. Hence, there would be no need to clamp it further. Why would a magazine be necessary with Esterly's device? The magazine of the present invention provides additional utility not possible with the device of Esterly; e.g., blade positioning, etc. Neither reference includes a suggestion or motivation to combine or to modify in the manner suggested, and the rejection does not cite support for such a combination / modification. Indeed, the lack of an appropriate motivation or suggestion to combine gives rise to an inference that the combination is the product of hindsight.

Regarding the additional limitations added within claims 14-16, applicants respectfully direct the Examiner to the remarks above and submit that it is clear that neither reference discloses a magazine such as that recited within claims 14-16.

For at least the reasons identified above, applicants respectfully request the Examiner withdraw the stated rejection and allow claims 13-16.

As applicants have traversed each rejection and objection raised by the Examiner, it is respectfully requested that the Examiner withdraw the stated rejections and

objections, and pass the present application on to issuance. In the event a fee is due, please charge our Deposit Order Account No. 13-0235.

Respectfully submitted,

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